

In re Patent Application of
Daniel Deutsch
Serial No. 10/759,542
Filed January 16, 2004

Remarks

Applicants appreciate the Examiner's careful review of the application and hereby respond to the outstanding Office action.

The Claims Are Patentable Over The Cited References

The Examiner has cited the Hsueh patent in combination with the reference by Vriens et al. (US Patent No. 5,813,753) as rendering independent claims 1 and 19 unpatentable as obvious under 35 USC 103(a). Applicants respectfully disagree for the following reasons.

The Examiner has recognized that the Hsueh reference does not describe "the LED being an Ultraviolet (UV) light emitting diode and the light housing having a fluorescent material." Applicants appreciate the Examiner's recognition that in the present invention the LED and the housing are separate structural and functional elements of the claimed device.

In that regard, Applicants point out that the Vriens et al. reference describes a new type of LED which generates light of a predetermined color by converting the UV/blue light emitted by the LED stack (21) to visible light through the use of phosphor grains (24) incorporated into the epoxy dome (25) of the LED.

Accordingly, it is clear that the combination of Hsueh and Vriens et al. teaches away from the present invention in which the light source or LED emits UV/near UV and the housing, a separate structural element of the claimed invention, has the fluorescent material. This combination, therefore, would have led the skilled to an invention different from the one claimed. In fact, even if Hsueh and Vriens et al. were

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combined, the combination would not result in the presently claimed invention, as there would be no housing having the fluorescent material.

Applicant respectfully also points out that the Hsueh reference was filed on September 25, 2000, a full two years following publication of the Vriens et al. reference. Applicant suggests that the fact that Hsueh, as an inventor and one of more than ordinary skill in the art, did not appreciate the possible use of the teachings of Vriens et al. in combination with his invention provides at least some showing that the presently claimed invention is nonobvious over the combined references.

Applicants, therefore, suggest that the combination of cited references has failed to establish a *prima facie* case of obviousness against the claims. In establishing a *prima facie* case of obviousness, the Examiner must establish three elements (MPEP §2143):

- 1) that the prior art contains a suggestion or motivation to combine the cited references in such a way as to achieve the claimed invention;
- 2) that one skilled in the art at the time the invention was made would have reasonably expected the claimed invention to work; and
- 3) that the combination must teach or suggest all the claim limitations, that is, that the combination produces the claimed invention.

As shown by Applicants, the combination of Hsueh and Vriens et al. fails to produce a housing having the fluorescent material, failing to establish requirement 3 above. Additionally, because the Vriens et al. reference teaches away from the claimed invention, required element 1 above is also not met, as when a reference teaches away there is no suggestion or motivation to combine the references.

For those reasons, Applicants respectfully request that the Examiner reconsider and withdraw the obviousness rejections of the claims.

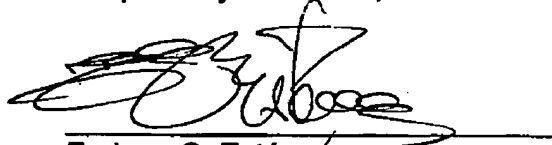
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Conclusion

Applicants have provided support for their assertion that the pending claims are novel and nonobvious over the cited references. Accordingly, Applicants suggest that the claims are allowable and that the application is in condition for allowance. Applicants respectfully request such action from the Examiner.

If the further prosecution can be facilitated through a telephone conference between the Examiner and the undersigned, the Examiner is respectfully requested to telephone the undersigned at his convenience.


Respectfully submitted,



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